UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,598	02/22/2002	Otis Franklin Bell	2871	5730

7

26822 7590 05/02/2003

WALTER A. HACKLER
2372 S.E. BRISTOL, SUITE B
NEWPORT BEACH, CA 92660-0755

EXAMINER	
FLETCHER III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,598	Applicant(s) BELL, OTIS FRANKLIN
	Examiner William Phillip Fletcher III	Art Unit 1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *21,22,25 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20,23 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Detailed Office Action

I. Restriction & Provisional Election

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 21, 22, 25, and 26, drawn to a composition for temporarily protecting a surface, classified in class 525, subclass 330.2.

II. Claims 1 - 20, 23, and 24, drawn to a method of temporarily protecting a surface, classified in class 427, subclass 282.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product (composition) as claimed can be used in a materially different process: a method in which the coating is not removed and remains permanently on the surface.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Walter A. Hackler (reg. no. 27,792) on 24 April 2003 a provisional election was made *without* traverse to prosecute the invention of group II,

claims 1 - 20, 23, and 24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21, 22, 25, and 26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

II. Form & Content of Application

IDS

The information disclosure statement (IDS) submitted on 22 February 2002 (paper no. 4) is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. An initialed, signed, and dated copy of the form PTO/SB/08A is attached to this action.

Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the *claims* are directed.

The following title is suggested: METHOD OF TEMPORARILY PROTECTING A SURFACE BY APPLICATION OF A COATING COMPOSITOION HAVING A CARBOXYLIC ACID-CONTAINING POLYMER FILM-FORMING COMPONENT.

Abstract

The abstract of the disclosure is objected to because it recites the following, which may be implied: "The present invention provides...". Correction is required. See MPEP § 608.01(b).

The following helpful information is provided to assist applicant in drafting a new abstract:

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

☞ The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

III. Rejections under 35 U.S.C. § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 9, 10, 12, 19, 20, and 24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 10 recite "...weight percent, polymer." It is unclear whether the polymer referred to here is the film-forming polymer of claim 1 or some other polymer entirely. If the former, then the examiner suggests claim language such as "said polymer," "said film-forming polymer," or "said film-forming, carboxylic acid-containing polymer," for clarity. If the latter, there is insufficient antecedent basis for this limitation in these claims.

Claims 9, 10, 19, and 20 recite weight percentages that render the claims indefinite. It is unclear what these measurements are in relation to: the total weight of the coating composition, the total solids weight of the coating composition, the total dry weight of the film, or something else entirely.

Claims 12, 19, 20, and 24 recite "said polymer." There is insufficient antecedent basis for this limitation in these claims. The examiner suggests claim language such as "said copolymer," "said film-forming copolymer," or "said film-forming, carboxylic acid-containing copolymer," for clarity.

IV. Rejections under 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 - 4, 6, 7, 9 - 14, 16, 17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts (US 5,453,459).

The rejections under this heading concern the embodiment in Roberts where the temporary coating system is used to protect against graffiti [c. 13, ll. 39 - 56]. In this instance, the protected surface is "decorated" with graffiti, which reads on applicant's step (b). The thus decorated protective coating is stripped from the surface, which reads on applicant's step (c).

With respect to claims 1 - 3 and 11 - 13, Roberts teaches a method of temporarily protecting a surface by applying a temporary protective coating composition comprising an aqueous dispersion of a film-forming acrylic polymer or copolymer and an acetylenically unsaturated nonionic surfactant, with all other components being optional [abstract; c. 2, ll. 21 - 28; c. 2, l. 60 - c. 3, l. 31; c. 4, l. 15, c. 5, l. 31; c. 13, ll. 39 - 56; and claims]. The acrylic polymer can be a polymer or copolymer of acrylic acid, or an acrylate; preferably a partially neutralized acrylic acid polymer or copolymer [c. c. 2, l. 60 - c. 3, l. 1]. Roberts requires only the surfactant in addition to the acrylic acid film-forming polymer or copolymer, examples of which

include SURFYNOL surfactants [c. 3, ll. 42 - 48]. Since applicant discloses, at p. 9, that their coating composition may also contain a surfactant, including SURFYNOL surfactants, it is the examiner's position that the addition of such a surfactant does not materially affect the basic and novel characteristics of the claimed invention [see *In re Herz*, 537 F.2d 549, 551 - 52, 190 USPQ 461, 463 (CCPA 1976) which presents a similar factual situation]. Consequently, Robert's composition reads on an aqueous solution or emulsion *consisting essentially of* a film-forming, carboxylic acid-containing polymer [see MPEP § 2111.03]. If applicant contends that the addition of surfactant is excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the addition of surfactant would materially change the characteristics of applicant's invention [see *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964)].

With respect to claims 4 and 14, Roberts teaches a motor vehicle surface [c. 1, ll. 15 - 50, 61, and 62; c. 5, ll. 42 - 48; c. 13, l. 30 - c. 14, l. 51].

With respect to claims 6, 7, 16, and 17, Roberts teaches the addition of alkali to neutralize the polymer [c. 3, ll. 25 - 31]. The pH of the coating composition is in the range of 7 to about 10.5, which includes applicant's claimed pH of "about 7.1" [c. 4, l. 15 - c. 5, l. 31].

With respect to claims 9, 10, 19, and 20, Roberts teaches from about 3 to about 25 wt.-% polymer, the lower endpoint of which falls within applicant's claimed range of "from about 2 to about 10" (claims 9 and 10), and which includes applicant's claimed "about 5" (claims 10 and 20) [c. 4, table at bottom].

V. Rejections under 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 4,453,459), as applied to claims 1 and 11, respectively, above, in further view of Zajac (WO 98/55535).

The teaching of Roberts is detailed above. Roberts does not explicitly teach that the protective coating composition comprises EDTA, although Roberts does teach the addition of conventional adjuvants [c. 4, ll. 44 - 53].

Zajac teaches a similar (meth)acrylic acid copolymer based protective coating composition to which EDTA is added as a chelating agent [abstract]. The EDTA improves the shelf-life of the protective coating composition by reducing the amount of sediment created during storage [p. 10, ll. 11 - 21].

Consequently, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method of Roberts so as to include, in the protective coating composition, EDTA. One of ordinary skill would have been motivated to do so by the

desire and expectation of improving the shelf-life of the coating composition, as described by Zajac.

4. **Claims 8 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 5,453,459), ass applied to claims 1 and 11, respectively, above, in further view of Maxwell et al. (US 6,011,107; hereinafter "Maxwell").

The teaching of Roberts is detailed above. Roberts is silent with respect to the viscosity of the claimed coating composition.

Maxwell teaches a similar (meth)acrylic acid copolymer based protective coating composition [abstract]. Maxwell teaches: "...the proportions of the various resins may be varied...so as to adjust the overall performance of the film" [c. 6, ll. 14 - 15]. Maxwell further teaches: "...the viscosity can be adjusted by varying the relative amounts of the resin components" [c. 6, ll. 23 - 24].

The examiner further notes that it is also well-known to adjust the viscosity of a coating composition by the addition of thickeners.

Consequently, the viscosity of the (meth)acrylic acid copolymer based protective coating composition is a result-effective variable, effecting the overall performance of the film, that may be adjusted by varying relative amounts of resin components or adding thickeners.

Absent a clear and convincing showing of unexpected results demonstrating the criticality of the claimed viscosity range, it would have been obvious to one of ordinary skill in the art to optimize the viscosity of the protective coating composition by routine experimentation

so as to achieve a desired overall performance of the coating composition [see MPEP § 2144.05(II)].

5. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 4,453,459), as applied to claims 1 and 11, respectively, above, in further view of Zajac (WO 98/55535) or in further view of Kawabata (US 5,194,483).

The teaching of Roberts is detailed above. Roberts further teaches that "[a]crylic acid copolymers with other vinyl monomers...which provide polymeric film-forming materials can also be used in the practice of this invention" [c. 3, ll. 18 - 24]. Roberts does not explicitly teach a copolymer of methacrylic acid and ethylacrylate.

Both Zajac and Kawabata teach similar (meth)acrylic acid copolymer based protective coating composition. Specifically, they both teach copolymers of methacrylic acid and ethylacrylate [Zajac, p. 6, l. 25 - p. 7, l. 30 and Kawabata, c. 3, ll. 17 - 29]. All of these references deal with removable, protective coating compositions for motor vehicle surfaces.

Since Roberts teaches a removable, protective coating composition in which copolymers of acrylic acid and vinyl monomers may be utilized as the only film-forming component, and Zajac and Kawabata each teach similar coating compositions utilizing copolymers of acrylic acid and ethylacrylate as film-formers, it would have been obvious to one of ordinary skill in the art to modify the method of Roberts so as to utilize, as the copolymer, a copolymer of methacrylic acid and ethylacrylate, as suggested by either Zajac or Kawabata. One of ordinary skill in the art

would have been motivated to do so by the desire and expectation of successfully forming a removable, protective coating.

VI. Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grogan et al. (US 5,143,949) provides information on the state of the art.

Herten et al. (US 4,540,736) teaches a removable, protective, carboxylic acid-containing polymer composition and method of application to a surface.

Ely et al. (US 5,550,182) provides information on the state of the art.

Goombes et al. (US 4,562,226) teaches a removable, protective, carboxylic acid-containing polymer composition and method of application to a surface.

Swidler (US 5,567,756) teaches a removable, protective, carboxylic acid-containing polymer composition and method of application to a surface.

Van Winckel (US 5,618,582) teaches a removable, protective, acrylic polymer composition and method of application to a surface.

Kashiwada et al. (US 5,716,667) teaches a removable, protective, acrylic polymer composition and method of application to a surface.

Swidler (US 5,719,221) teaches a removable, protective, acrylic polymer composition and method of application to a surface.

Swidler (US 6,124,044) teaches a removable, protective, acrylic polymer composition and method of application to a surface.

Zajac (US 6,391,961 B1) issued from the national stage of WO 98/55535, cited above.

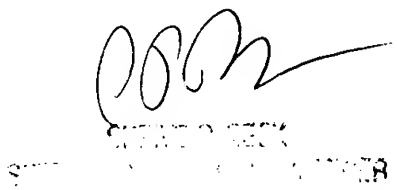
VII. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Phillip Fletcher III whose telephone number is (703) 308-7956. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William Phillip Fletcher III
Patent Examiner
United States Patent & Trademark Office
Group Art Unit 1762



wpf
April 28, 2003